



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,311	01/22/2002	Jan-Michael Peters	0652.2290001	4782
26111	7590	10/17/2003	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			FRONDA, CHRISTIAN L	
			ART UNIT	PAPER NUMBER
			1652	13

DATE MAILED: 10/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,311

Applicant(s)

PETERS ET AL.

Examiner

Christian L Fronda

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1652

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Group I, claims 1-6, in Paper No. 14 is acknowledged. The traversal is on the grounds that a prior art search of Group I would encompass a search for Groups II and III. This is not found persuasive for reasons of record and the reasons stated below.

Each of the products of Groups II and III are independent chemical entities and require different literature searches. The substrate peptide of Group II is not the claimed inhibitor of Group III. The process of Group I do not require the product of Group III. The process (Group I) for using the product (Group II) as claimed can be practiced with another materially different product such as using SCC1 as the substrate.

A search of all the inventions in the patent literature and the non-patent literature cannot be made without serious burden because the inventions require separate searches that have different limits, boundaries, scope, and subject matter. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter, restriction for examination purposes is proper.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-6 are under consideration in this Office Action.

Nucleotide Sequence and/or Amino Acid Sequence Disclosures

3. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 since claim 6 recites amino acid sequences which are at least four amino acid residues in length (See MPEP 2421.02).

Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing", an initial paper copy or compact disc copy of the "Sequence Listing", as well as an amendment directing its entry into the application. Applicant must also provide a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 C.F.R. 1.821(e), 1.821(f), 1.821(g), 1.825(b), 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the Patent and Trademark Office, such request in accordance with 37 C.F.R.

Art Unit: 1652

1.821(e) may be submitted in lieu of a new CRF.

Applicant must comply with the sequence rules, 37 CFR 1.821- 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g).

Claim Rejections - 35 U.S.C. § 112, 1st Paragraph

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are directed to any method for identifying compounds that modulate sister chromatid separation using any sseparase or fragment thereof of any amino acid sequence/structure and biological order and any substrate of any amino acid sequence/structure. However, the specification only provides a written description of a method directed toward screening for test compounds that inhibit human recombinant separase activity using fluorogenic peptide substrates SFEILR-AMC, SFEILRG-AMC, EWELLR-AMC, AND DREIMR-AMC. The specification does not provide a written description of any method for identifying compounds that modulate sister chromatid separation using any sseparase or fragment thereof of any amino acid sequence/structure and biological order and any substrate of any amino acid sequence/structure.

Applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise, and exact terms that a skilled artisan would recognize Applicants were in possession of the claimed invention. Claims 2-5 which depend from claim 1 are also rejected because they do not correct the defect of claim 1.

Claim Rejections - 35 U.S.C. § 112, 2nd Paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

10051311.100

Art Unit: 1652

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

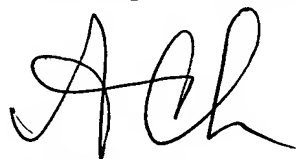
Claim 1 is vague and indefinite because the definition and meaning of the phrase "modulating sister chromatid separation" is not known or recited. Furthermore, the recited method is confusing since the examples in the instant specification show a method directed toward screening for test compounds that inhibit human recombinant sseparase activity using fluorogenic peptide substrates SFEILR-AMC, SFEILRG-AMC, EWELLR-AMC, AND DREIMR-AMC. It is not clear how all the recited steps lead to the identification of any test compound that has the ability of "modulating sister chromatid separation". Claims 2-6 which depend from claim 1 are also rejected because they do not correct the defect of claim 1.

Conclusion

8. No claim is allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L. Fronda whose telephone number is (703)305-1252. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703)308-3804. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-0196.

CLF



PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600